

REMARKS

Upon entry of the present amendment, claims 1, 2, 3-7 and 1-22 remain in the application. Claims 7 and 11 are canceled without prejudice. Claims 3, 8-10, 23 and 24 are withdrawn from consideration.

35 USC §112 Rejections

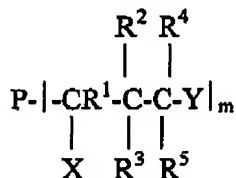
Claims 1, 2, 4-7 and 18-22 are rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The claims were stated to contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s) at the time of the application was filed, had possession of the claimed invention. The office action stated that the term "compound" is not defined with adequate specificity. Applicants have amended the claims to define that P is selected from oligomers and polymers. Withdrawal of the rejection is respectfully requested.

Claims 1, 2, 4-7, 12-14, 15-17 and 18-22 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. It was stated that in the formula it was unclear how "m" can be more than 1, since there is no open valency for a repeating unit.

The formulation has been amended to show that the group modified by "m" is the entire group amended to "P". Withdrawal of the rejection is therefore respectfully requested.

35 USC §103

Claims 1, 2, 4-7, 12-14, 15-17 and 18-22 were rejected under 35 USC §103(a) as being unpatentable over US patent number 5,907,024 to Ohrbom et al. The office action stated that the rejected claims cover, inter alia, a gamma hydroxyl carbamate comprising one or more of the following structures of the formula

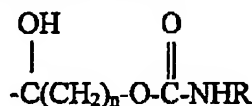


$\text{R}^1, \text{R}^2, \text{R}^3, \text{R}^4$, and R^5

Ohrbom was cited for teaching a curable coating composition that includes a compound having both hydroxy functionality and carbamate functionality.

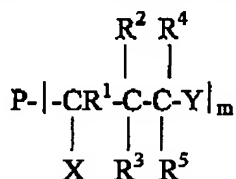
The office action stated that Ohrbom taught the elements of the claimed invention with sufficient guidance, particularity and with a reasonable expectation of success, that the invention would be prima facie obvious to one of ordinary skill in the art.

Applicants submit that the amended claims are patentable over the cited art for the reason that the reference is directed to beta-hydroxy carbamate compounds, (Specification, col. 10, lines 45-48,) of the formula:



where n is an integer from 0 to about 6, preferably 1.

In contrast, the instant claims define gamma hydroxy carbamate compounds of the formula:



where R^1 , R^2 , R^3 , R^4 , and R^5 are not all hydrogen. This differs from the reference where it is required that all of the variables are hydrogen. The present invention teaches away from the reference. In the instant specification it is stated that substituents in the gamma hydroxy carbamate do not include beta hydroxyl groups, i.e. hydroxyl groups that are attached to a carbon that is adjacent to a carbon atom attached to a primary carbamate group. In the specification at page 6, lines 23-26, it states that "All hydroxyl groups present in the gamma hydroxy carbamate primary carbamate functional group must be at least gamma or higher, i.e., there must be one or more carbons between the carbon to which the primary carbamate group is attached and the carbon to which the hydroxyl is attached."

The present invention provides advantages over the prior art. The beta hydroxy carbamate compounds of the prior art are known to decompose, particularly in water or in the presence protic solvents to form ammonia and cyclic carbonates. In comparison, the gamma hydroxyl carbamate defined in the instant claims is stable and forms a 6- membered ring that does not decompose to cyclic carbamate in water or protic solvents. This makes coating compositions containing the gamma hydroxy carbamates more stable when a coating is a water based system or uses protic solvents. The gamma hydroxyl carbamate compounds are not taught, suggested or defined in the

reference. For these reasons, Applicant submits that the gamma hydroxy carbamate compounds are not prima facie obvious to one of ordinary skill in the art.

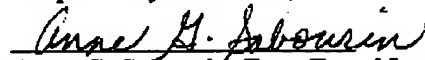
In view of the amendments to the claims and the arguments set forth herein, Applicants respectfully request withdrawal of the obviousness rejection.

Double Patenting

Claims 1, 2, 4-7, 12-14, 15-17 and 18-22 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of US Patent 6,858,674. Applicants submit herewith a terminal disclaimer to overcome the double patenting rejection.

In view of the amendments to the claims and submission of the terminal disclaimer, Applicants submit that the claims are patentable over the cited art and respectfully request withdrawal of the rejections and allowance of the claims.

Respectfully submitted,


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